

Serial No. 09/558,755
Page 10 of 15

REMARKS

This response is intended as a full and complete response to the final Office Action mailed July 9, 2007.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are obvious under the provisions of 35 U.S.C. §103.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

35 U.S.C. §103(a) Rejection of Claims 1-3, 7-10, 13, 14, 20, 22, 24, 26-38, 42, 43, 46-57, and 62-63

Claims 1-3, 7-10, 13, 14, 20, 22, 24, 26-38, 42, 43, 46-57, and 62-63 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth et al. (USPN 6,285,987, hereinafter "Roth") in view of Armbruster et al. (USPN 6,243,760, hereinafter "Armbruster"), in further view of Bull et al. (USPN 6,208,975, hereinafter "Bull"). The rejection is traversed.

According to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The combination of Roth, Armbruster and Bull fails to establish a *prima facie* case of obviousness, because the combination fails to teach or suggest all the elements of the claimed invention. For example, the combination fails to teach or suggest the claimed using a computer to monitor user access to said plurality of Web

Serial No. 09/558,755

Page 11 of 15

sites by identifying the URL requests made by the user at the Internet Service Provider (ISP) point of presence (POP).

The Examiner concedes that Roth fails to teach or suggest this limitation in the Office Action. (See Office Action, p. 3, ll. 8-9). However, the Examiner alleges that Armbruster teaches the above limitations.

The Applicants respectfully submit that Armbruster fails to teach or suggest at least the limitation of using a computer to monitor user access to said plurality of Web sites by identifying the URL requests made by the user at the Internet Service Provider (ISP) point of presence (POP). Armbruster teaches that an ISP caching complex located near an ISP's point of presence is used for the content providers to access its own cacheable files. (See Armbruster, col. 4, l. 1 – col. 5, l. 22). Notably, the content provider chooses to whom the content provider's web page may be distributed to based upon choices provided by an ISP. (See *Id.*) Therefore, the caching complex taught by Armbruster cannot be used for profiling a web user based upon monitoring user access to said plurality of Web sites by identifying the URL requests made by the user at the Internet Service Provider (ISP) point of presence (POP).

To illustrate, Armbruster at best can only be used monitor which files a user access from a single website. The URL's depicted by Armbruster are only of the "cacheable items" from the content provider's website. (See Armbruster, col. 4, ll. 45-49). As such, the URL's will only change by the file extension, e.g., http://www.cp1.com/"file name". As a result, Armbruster will provide a less comprehensive user profile because Armbruster may only monitor what cacheable items are selected from a content provider's single website. In contrast, the Applicants' invention provides a more comprehensive web user profile because the web user profile is based upon monitoring user access to a plurality of Web sites. Therefore, Armbruster does not teach or suggest the ability to profile a web user based upon monitoring user access to said plurality of Web sites by identifying the URL requests made by the user at the Internet Service Provider (ISP) point of presence (POP) because Armbruster teaches the content provider already knows who the web page is being distributed to and only is concerned with those accessing its own webpage and not monitoring user access to a plurality of Web sites. The ISP caching complex located near the ISP's point of presence is for accessing a content provider's own files

588151-1

Serial No. 09/558,755
Page 12 of 15

a single website and not for monitoring user access to said plurality of Web sites by identifying the URL requests made by the user at the Internet Service Provider (ISP) point of presence (POP).

Moreover, Bull fails to bridge the substantial gap left by Roth and Armbruster. Bull also does not teach or suggest at least the limitation of using a computer to monitor user access to said plurality of Web sites by identifying the URL requests made by the user at the Internet Service Provider (ISP) point of presence (POP).

Moreover, the Applicants respectfully submit that Armbruster cannot be meaningfully combined with Roth and Bull. The Applicants respectfully submit that the art is not as broad as categorized by the Examiner, i.e. "effective storage and retrieval of information". (See Office Action, p. 3, ll. 19-21.) The Applicants respectfully submit that the art is much narrower and concerned with the art of profiling web users. Armbruster is not concerned with profiling web users, but rather with information dissemination. In contrast, Roth and Bull address the issue of profiling web users with aggregated information.

The Examiner responds by stating that Armbruster is concerned with the storage of Internet web content at the provider level, which is particularly relevant in determining what sites a viewer has accessed in various periods of time. (See Final Office Action, p. 15, l. 21 – p. 16, l. 1). To the contrary, Armbruster is concerned with the storage of content from a single website of a content provider, which only will provide information as to what "cacheable files" a viewer has accessed in various periods of time from a single particular website and not "sites" as alleged by the Examiner. Therefore, as discussed above, Armbruster, Roth and Bull cannot be meaningfully combined.

Therefore, independent claim 1 is patentable over the combination of Roth, Armbruster and Bull. Furthermore, each of the other independent claims, 22, 31, 32, 53, and 56, recites relevant limitations similar to those recited in independent claim 1. As such, for at least the reasons noted above, claims 22, 31, 32, 53, and 56 are also patentable over Roth, Armbruster and Bull.

Claims 2, 3, 7-10, 13, 14, and 20 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1. Therefore, claims 2, 7-10, 13, 14, and 20 are also patentable over the combination of Roth, Armbruster and Bull.

588151-1

Serial No. 09/558,755

Page 13 of 15

Claims 24 and 26-30 depend, directly or indirectly, from claim 22 and, thus, inherit the patentable subject matter of claim 22. Therefore, claims 24 and 26-30 are also patentable over the combination of Roth, Armbruster and Bull.

Claims 33-38, 42, 43, 46-52 and 54-55 depend, directly or indirectly, from claim 32 depend, directly or indirectly, from claim 32 and, thus inherit the patentable subject matter of claim 32. Therefore, claims 33-38, 42, 43 and 46-52 are also patentable over the combination of Roth, Armbruster and Bull.

Claims 54-55 depend directly from claim 53 and, thus, inherit the patentable subject matter of claim 53. Therefore, claims 54-55 are also patentable over the combination of Roth, Armbruster and Bull.

Claims 57, 62, and 63 depend, directly or indirectly, from claim 56 and, thus, inherit the patentable subject matter of claim 22. Therefore, claims 57, 62, and 63 are also patentable over the combination of Roth, Armbruster and Bull.

35 U.S.C. §103(a) Rejection of Claims 15-18

Claims 15-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Armbruster, in further view of Bull, in further view of Sheena et al (USPN 6,049,777, hereinafter "Sheena"). The rejection is traversed.

Claims 15-18 depend, directly or indirectly, from claim 1 and, thus, inherit the patentable subject matter of claim 1. Sheena adds nothing with regard to the above-mentioned deficiencies of Roth. Therefore, claims 15-18 are patentable over the combination of Roth, Armbruster, Bull and Sheena.

35 U.S.C. §103(a) Rejection of Claim 19

Claim 19 is rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Armbruster, in further view of Bull, in further view of Eldering (USPN 6,298,348, hereinafter "Eldering"). The rejection is traversed.

Claim 19 depends from claim 1 and, thus, inherits the patentable subject matter of claim 1. Eldering adds nothing with regard to the above-mentioned deficiencies of Roth, Armbruster and Bull. Therefore, claim 19 is patentable over the combination of Roth, Armbruster, Bull and Eldering.

588151-1

Serial No. 09/558,755
Page 14 of 15

35 U.S.C. §103(a) Rejection of Claims 21 and 58-61

Claims 21 and 58-61 are rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Armbruster, in further view of Bull, in further view of Park et al. (USPN 6,295,061, hereinafter "Park"). The rejection is traversed.

Claim 21 depends indirectly from claim 1 and, thus, inherits the patentable subject matter of claim 1. Park adds nothing with regard to the above mentioned deficiencies of Roth, Armbruster and Bull. Therefore, claim 21 is patentable over the combination of Roth, Armbruster, Bull and Park.

Claims 58-61 depend, directly or indirectly, from claim 56 and, thus, inherit the patentable subject matter of claim 56. Park adds nothing with regard to the above mentioned deficiencies of Roth, Armbruster and Bull. Therefore, claims 58-61 are patentable over the combination of Roth, Armbruster, Bull and Park.

35 U.S.C. §103(a) Rejection of Claim 25

Claim 25 is rejected under 35 U.S.C. §103(a) as being unpatentable over Roth in view of Armbruster in further view of Bull, in further view of Haitsuka et al. (USPN 6,366,298, hereinafter "Haitsuka"). The rejection is traversed.

Claim 25 depends from claim 22 and, thus, inherits the patentable subject matter of claim 22. Haitsuka adds nothing with regard to the above-mentioned deficiencies of Roth, Armbruster and Bull. Therefore, claim 25 is patentable over the combination of Roth, Armbruster, Bull and Haitsuka.

SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicants' disclosure than the primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

Serial No. 09/558,755
Page 15 of 15

CONCLUSION

Thus, Applicants submit that all of the claims presently in the application are in allowable form. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim, at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 9/7/07



Eamon J. Wall
Registration No. 39,414
Attorney for Applicant(s)

PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808